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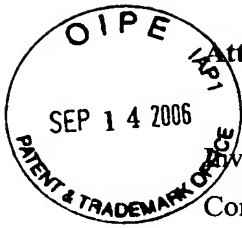
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1046_028	
		Application Number 10/604,114	Filed June 26, 2003
		First Named Inventor Nathan C. Thompson et al.	
		Art Unit 2627	Examiner T. Chen
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,551</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p>Signature:  Kenneth Altshuler Typed or printed name</p> <p>(315) 425-9000 Telephone number</p> <p>9/13/06 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☐ *Total of 1 forms are submitted.

Pre-Appeal Brief Request for Review	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. <u>EV 676 908 049 US</u> , on the date shown below in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Dated: <u>9/14/06</u>	Signature: <u>Cynthia Losurdo</u> (Cynthia Losurdo)



Attorney Docket No.: 1046_028

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Thompson, Nathan C.; Permut, Ronald M.; Sutherland, Lee A.
Confirmation No.: 1113
Serial No.: 10/604,114 Art Unit: 2627
Filed: June 26, 2003 Examiner: Tianjie Chen
Customer No.: 20874
Title: MAGAZINE-BASED DATA CARTRIDGE LIBRARY

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I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 addressed to Mail Stop AF Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 14, 2006, under "EXPRESS MAIL" mailing label number EV676908049US.

Cynthia L. Losurdo
Cynthia L. Losurdo

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Advisory Action mailed on August 28, 2006 ("the Advisory Action"), Applicant requests that the Panel's objective review will conclude that all the outstanding issues, some being reiterated herein summarily, are not bona fide matters for appeal, but rather are issues that clearly should be resolved on Applicant's favor based upon the record. Please enter the following remarks as Applicant's bases for filing this Pre-Appeal Brief Request for Review.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED A PRIMA FACIE CASE OF OBVIOUSNESS BY FAILING TO: A) ADEQUATELY MAKE A SHOWING THAT THE PRIOR ART REFERENCES TEACH OR SUGGEST ALL OF THE CLAIM LIMITATIONS OF INDEPENDENT CLAIMS 1 AND 21 AND B) SUBSTANTIATE A REASONABLE MOTIVATION TO COMBINE AND MODIFY THE PRIOR ART REFERENCES

Rejection of claims 1 and 21 under § 103(a) over U.S. Patent No. 5,442,500 to Hidano et al. (hereinafter referred to as "Hidano") in view of U.S. Patent No. 5,818,723 to Dimitri (hereinafter referred to as "Dimitri"):

The Examiner has failed to properly construe the references in relation to independent claim 1. For example, the Examiner's construction of Hidano's device related to the

Applicant's claimed invention consists of non-analogous elements. Examiner incorrectly analogizes one of Hidano's cartridge racks 2a with Applicant's first frame and another of Hidano's cartridge racks 2a with Applicant's second frame. Hidano does not disclose, teach or suggest passing a magazine, or a data cartridge for that matter, through a passageway extending through a portion of a side of one of Hidano's cartridge racks 2a into another of Hidano's cartridge racks 2a through a portion of the other cartridge rack 2a. The Examiner tries to prep up his flawed his analysis that two cartridge racks 2a are equivalent to Applicant's two frames, in both the Final Office Action of June 14, 2006 and Advisory Action of August 28, 2006, by concocting two planar elements to Hidano's FIG. 2 and labeling them side 1 and side 2. Hidano's disclosure simply will not support such a contrived interpretation. **See Applicant's Response After Final file 8/14/2006, ppg. 9 and 10.** In another example, the Examiner analogizes Hidano's guide rail 86 with Applicant's passageway. A guide rail and a passageway neither are equivalent structures nor carry out equivalent functions, as Applicant discusses by way of both illustration and definition. **See Applicant's Response After Final file 8/14/2006, ppg. 9 and 10.** In yet another example, the Examiner interprets Dimitri as having two analogous frames, the right and left elements 128, to that of Applicant's first and second frames. However, Dimitri's elements 128 are rails for supporting plates 66 and are not two frames with sides through which passageways are formed. By contriving analogies to disparate elements found in the combined references of Hidano and Dimitri, the Examiner fails to establish that the combined reference includes each of the elements recited in claim 1, and therefore the Examiner has failed to establish a reasonable case of *prima facie* obviousness.

In addition, the Examiner has failed to carry his burden of making a *prima facie* showing that one of ordinary skill in the art would have been motivated to combine the relevant disclosures of Hidano and Dimitri. The Examiner offers only an unsupported conclusory rational for finding a motivation to combine Hidano with Dimitri:

One of ordinary skill in the art would have been motivated to add the magazine transport function onto the cartridge transport device in Hidano et al.'s device, thus speed [sic, "speeding"] up the processing process.

Final Office Action at 3. Such a rationale is hardly the "thorough and searching" factual inquiry required to support the Examiner's combination of the teachings of the references,

especially since Hidano and Dimitri are directed entirely to solving different problems relation to their disclosed systems and in relation to Applicant's claimed data cartridge library. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

Applicant's invention is directed to increasing density, hence at the time of the invention, one skilled in the art would not have been motivated to combine Dimitri and Hidano because they teach principally conflicting technology: Hidano increases storage capacity and Dimitri decreases storage capacity. Hidano is directed to increasing the capacity of a storage system at the cost of density, i.e., single cartridge storage infinite add-on units. Whereas, Dimitri is directed to increasing the speed of operation of a storage system, at the cost of capacity, while reducing the downtime associated with the failure of "a picker and/or transport assembly." Also notably, Dimitri teaches having magazine storage bins with "front open sides" and "back open sides," to allow for quicker access to stored media at the cost of density.

With regards to independent claim 21, again the Examiner has failed to substantiate the requisite prima facie case of obviousness because the cited references, neither alone nor in combination, teach or suggest all of the features as recited in independent claim 21. In addition to the lack of a thorough analysis directed to issues as discussed in conjunction with claim 1, in both the final Office Action of 6/14/2006 and the Advisory Action of 8/28/2006, the Examiner has been silent to Applicant's arguments that neither the first and second side surface features of claim 21 are disclosed by Hidano nor Dimitri. By virtue of the Examiner's silence to Applicant's arguments, the Examiner implicitly acknowledges the merits of Applicant's arguments.

Rejection of claim 1 under § 103(a) over U.S. Patent No. 6,813,113 to Mueller et al. (hereinafter referred to as "Mueller") in view of Dimitri.

The Examiner has failed to identify where each corresponding element recited in claim 1 is found in Mueller. See **Applicant's Response After Final filed 8/14/2006, ppg. 11 and 12.** The Examiner failed to identify the structures or components in Mueller that are allegedly equivalent to Applicant's first and second frames. Not only does the Examiner misconstrue claim language like "within" versus "into", but the Examiner was silent to Applicant's remarks disputing the analogy to a first frame that defines a first side. Further,

the Examiner analogizes Mueller's side portion 38 of the cartridge handling system 28 to Applicant's second passageway, without specifying whether the magazine 20, the drawer 16, the data storage system 12 or something else is the frame. **See Applicant's Response After Final file 8/14/2006, pg. 12.** The Examiner has difficulty in pointing out where the claimed elements are found in the cited references because they do not exist in these references.

Applicant has submitted that the Examiner's combination of Hidano in view of Dimitri and Mueller in view of Dimitri would not have rendered the Applicant's claimed invention obvious because certain features of Applicant's claimed invention are not present in the references. Because of this flaw, and for additional reasons, the Examiner has been unable to demonstrate any rational for a motivation to combine the teachings of the references.

Applicant requests that the Pre-Appeal Board allow the pending claims.

* * *

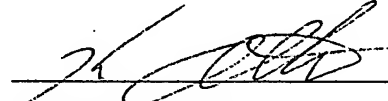
Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-0289.

Respectfully submitted,

Dated: _____

9/13/06



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